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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,752	03/30/2000	Jay S. Walker	99-075	8956
22927	7590	01/25/2005	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			RADA, ALEX P	
			ART UNIT	PAPER NUMBER
			3714	
DATE MAILED: 01/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	Application No. 09/538,752	Applicant(s) WALKER ET AL.	
	Examiner Alex P. Rada	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

In response to the amendment filed October 25, 2004 in which the applicant amends claim 1, cancels claim 11, previously cancelled claims 35-39, and claims 1-10 and 12-34.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-10 and 12-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in tow-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

Technological Arts Analysis

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

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In the present case, claims 25-33 recite an abstract idea. The claimed method does not apply, use or advance the technological arts. The recited steps merely determine if the plurality of hands, first and second hands, and a hand of blackjack have resulted in a push, and based on a random outcome, determine if the player has won at least one of plurality of hands, determine if the plurality of players have won the plurality of hands, determine if the player has won the first and second hands, and determine if the player has won the hand of blackjack does not apply, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to determine if a hand of blackjack is won as result of a push.

Useful, Concrete and Tangible Analysis

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

In the present case, claims 1-10 and 12-34 provides a useful result, which the result can be used for a purpose and a tangible result in that the determination of a hand or a plurality of hands or the like are reasonable expectation of success. Claims 1, 3-10 and 12-34 do not constitute a concrete result. Although a determination is made regarding the hand or a plurality of hands blackjack, the result is never functionally used or displayed. In the instant case the result of the push is decided, however, the winner is never notified of a result. Claim 2 is concrete because the player is receiving a payment of a winning amount based on the wager amount.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-10 and 12-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claim 1, the language of, “generating an additional random outcome” is vague and indefinite because an initial random outcome or a first random outcome must take place before a second or additional random outcome occurs.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claim 33 is rejected under 35 U.S.C. 102(e) as being anticipated by Hesse (US 5,803,460.

7. Hesse discloses the following:

Receiving an indication (verbal) that the hand of blackjack has resulted in a push, and transmitting a random outcome in response to the receiving, in which the examiner interprets the verbal indication by the dealer to be equivalent to the transmitting (verbally) the random outcome to determine if the player has won the hand of blackjack as recited in claim 33.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-10, 12-24 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hesse (US 5,803,460) in view of Feola (US 5,746,432).

10. Hesse discloses the following:

A card game similar to the principles of blackjack including dealing a first set of accumulated cards to a player, dealing a second set of accumulated cards to a dealer, determining that the hand of blackjack has resulted in a push (figures 6-8), in response to the determining, generating an additional random outcome and

based on the random outcome, and determining if the player has won the hand of blackjack (column 6, lines 10-13 and column 13, lines 44-46) as recited in claim 1.

Receiving from the player an indication of a wager amount associated with the hand of blackjack, the receiving being performed prior to the determining that the hand of blackjack resulted in the push and after the determining if the player has won the hand of blackjack, arranging for the player to receive payment of a winning amount based on the wager amount (column 6, lines 10-13 and column 13, lines 44-46) as recited in claim 2.

Deciding if the push will be resolved as recited in claim 3.

Determining that the hand of blackjack has resulted in the push, the player indication of whether the push will be resolved as recited in claim 4.

Displaying an indication of the random outcome to the player, in which the examiner interprets the drawing of the additional card on the gaming table to be an equivalent to the displaying an indication of the random outcome to the player as recited in claim 5.

Generating the random outcome, in which the examiner interprets the drawing one additional card to be an equivalent to the generating the random outcome as recited in claim 7.

The generating is performed after and in response to the determining that the hand of blackjack has resulted in the push (column 6, lines 10-13 and column 13, lines 44-46) as recited in claims 8-9.

The generating is performed using a set of playing cards and the a set used in the hand of blackjack as recited in claims 16-17

Arranging for the player to receive payment of a winning amount as recited in claim 19.

The winning amount is based at least in part on the random outcome (column 6, lines 24-32) as recited in claim 20.

Displaying the winning amount to the player as recited in claim 21.

The winning amount is based at least in part on at least one of: information associated with the player and at least one card accumulated by the player or a dealer in the hand of blackjack, in which the examiner interprets the drawing the additional card to be an equivalent to information associated with the player and at least one card accumulated by the player or a dealer in the hand of blackjack (column 6, lines 10-13 and column 13, lines 44-46) as recited in claim 22.

The random outcome having a first state indicating that the player has won the hand of blackjack and a second state indicating that the player has not won the hand of blackjack, in which the examiner interprets the drawing of the additional card and the party drawing the higher (or lower) card depending rules governed by the gambling establishment to be an equivalent to the first state indicating a win or a second state indicating no win (column 6, lines 10-13 and column 13, lines 44-46) as recited in claim 23.

Receiving a wager amount associated with the hand of blackjack, determining that the hand of blackjack has resulted in a push, based on the random outcome, displaying to the player an indication of at least one of the random outcome and determination if the player has won the hand of blackjack,

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and arranging for the player to receive payment of the winning amount based on the wager amount (column 6, lines 10-13 and column 13, lines 44-46) as recited in claim 34.

Hesse does not expressly disclose the following:

The random outcome is statistically independent of the hand blackjack prior to the push as recited in claims 1 and 34.

Initiating a random outcome generator and receiving an indication of the random outcome as recited in claim 6.

The generating is performed using a rotating wheel as recited in claim 15.

The random outcome has a plurality of sates, at least two of the plurality of sates being associated with different winning amounts as recited in claim 24.

Feola teaches the following:

A random outcome (spinning wheel) being statistically independent of the hand blackjack and is capable of being played before or after the push as recited in claims 1 and 34.

Initiating a random outcome generator and receiving an indication of the random outcome, in which the examiner interprets the rotating wheel and the results of the wheel to be equivalent to Initiating a random outcome generator and receiving an indication of the random outcome as recited in claim 6.

A blackjack type game wherein if the outcome is a push the wheel is used to determine a win based on the generating being performed using a rotating wheel (figure 2 and column 2, line 56 – column 3, line 6) as recited in claim 15.

The random outcome has a plurality of sates, at least two of the plurality of sates being associated with different winning amounts, in which the examiner interprets the tie breaker card is between ten through a King all wheel and card bets paid to the players and ten and under goes to the establishment to be an equivalent to at least two of the plurality of sates being associated with different winning amounts (column 3, lines 1-6) as recited in claim 24.

By using a wheel to as a random generation to resolve a tie, one of ordinary skill in the art would provide definite unbiased game result.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Hesse to include a rotating wheel a generating outcome as taught by Feola to provide definite unbiased game result.

At the time the invention was made, it would have been an obvious design choice to a person of ordinary skill in the art to provide different types of random generated outcomes using at least one die, a coin, a random number generator, a set of cards other than a set used in the hand of blackjack, and generating being performed prior to the determining that the hand of blackjack has resulted in the push. Lot devices are well known in the art and used for different types of gaming machine designs or applications. For example, if one were to design a table game one would use a pair of dice or if one were to design an electronic gaming machine one would use a random number generator. By having different types of lot devices, one of ordinary skill in the art would provide any type of gaming machine with a consistent random unbiased result.

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11. Claims 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hesse (US 5,803,460) in view of Moody (US 5,954,335).

12. Hesse discloses the following:

A card game similar to the principles of blackjack determining that the hand of blackjack has resulted in a push, and based on a random outcome, determining if the player has won the hand of blackjack (column 6, lines 10-13 and column 13, lines 44-46) as recited in claims 25, 28, and 30.

A separate or random outcome capable of determines if the player has won each or all of the hands of blackjack (column 6, lines 10-13 and column 13, lines 44-46) as recited in claims 26-27 and 29-30.

Receiving an indication (verbal) that the hand of blackjack has resulted in a push, and transmitting a random outcome in response to the receiving, in which the examiner interprets the verbal indication by the dealer to be equivalent to the transmitting (verbally) the random outcome to determine if the player has won the hand of blackjack (column 6, lines 10-13 and column 13, lines 44-46) as recited in claim 33.

Hesse does not expressly disclose the following:

Playing a plurality of hands of blackjack as recited in claims 25 and 28.

The second hand of blackjack is played after the first hand of blackjack is played as recited in claim 32.

Moody teaches the following:

Playing a single of multiple hands of blackjack (figures 1-4) as recited in claims 25, 28, and 31-32. By playing a single or multiple hands of blackjack one of

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ordinary skill in the art would provide game players multiple opportunities to win whenever good hands are achieved.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Hesse to include playing a plurality of hands as taught by Moody to provide game players multiple opportunities to win whenever good hands are achieved.

Response to Arguments

13. Applicant's arguments with respect to claims 1-10 and 11-34 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 571-272-4452. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


APR

JESSICA HARRISON
PRIMARY EXAMINER